



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/771,049

02/02/2004

John N. Gross

JNG 2004-5

1525

23694 7590 05/18/2007
J. NICHOLAS GROSS, ATTORNEY
2030 ADDISON ST.
SUITE 610
BERKELEY, CA 94704

EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

05/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/771,049

Applicant(s)

GROSS, JOHN N.

Examiner

Dennis Ruhl

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-18, 21-25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-7, 10-18 and 21-24 is/are allowed.
- 6) ☒ Claim(s) 8, 9, 25, 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 3629

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/28/07 has been entered.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 25, 27-29, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 25, the language "further comprising adding said additional playable media item to said subscriber rental queue unless removed by the subscriber within the time period specified in said notification" is indefinite. How can it be claimed that the media item is added unless it is removed. You cannot remove something before it has been added, so what does it mean to claim that the media item is added unless removed by the subscriber? This makes no sense. The media item has not been added yet, so how can it be removed before it is added to the rental queue? It is not clear what this language means. It is not clear what the scope of this language is and one wishing to avoid infringement would not know what it means.

Art Unit: 3629

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9,25-34, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al. (6584450) in view of Elston (6055505).

For claims 30-32,34,Hastings discloses a method for renting items from a content provider where the customer sets up a rental queue by interacting with a website via the Internet. A set of queue replenishment rules is employed to determine if the ordering of the titles in the queue should be changed. When a DVD is returned the system checks the queue rules (Max Out option and/or Max Turns) to determine if the ordering of the queue should be changed. When a new DVD is shipped, the ordering of the queue is changed because that title is taken out of the queue and is then in a checked out status. The subscriber chooses the ordering of the titles that are to be delivered. With respect to the addition of an additional playable media item to the subscriber rental queue, Hastings discloses that the subscriber can choose preferences/attributes about what movies they would like to see and the content provider will automatically select those movies for the subscriber (a item recommendation system). See column 8, lines 43-60. This is considered to be the claimed item recommendation system because this aspect of the system of Hastings recommends movies based on the preferences that the subscriber has provided (i.e. horror movies released in 1999 or any adventure movies with Harrison Ford as an actor). The movies determined by the recommendation

Art Unit: 3629

system are added to the queue as claimed (part g). With respect to the limitation of "interacting with the subscriber using embedded URL's" so as to *allow* the subscriber to review playable media title recommendations from the recommender system, the examiner notes that when a title is added to the queue by the recommendation system, the subscriber can use the URL for the website to review the movie by visiting the website. This ability is present in Hastings. The subscriber can go to the website (by using the website URL) and get more information on the movie that the item recommendation system has added to the rental queue. The examiner notes that the "response field in the electronic notification" is not required in the claim because of the "and/or" language. Not disclosed is a set of notification rules that will electronically notify the subscriber when the ordering of the queue has been changed based on the monitoring of the queue and based on whether or not the queue is at or below a threshold number. Elston discloses an automatic customer notification system that notifies customers of a business or other entity of the fact that an event has occurred that involves that business or entity. Elston discloses that when an event of interest to the customer occurs, the system will notify the customer by phone, fax, or even email. See column 4, lines 1-5. Elston discloses in column 5, lines 3-12 that the system and method of customer notification can be used for accounts at financial institutions, for medical patients and test results, for college students and notification of the posting of grades. The invention is not limited to just the notification of financial events but can be used in other environments where notification of an event would be desirable. It would have been obvious to one of ordinary skill in the art at the time the invention was made

Art Unit: 3629

to provide Hastings with a notification system as disclosed by Elston so that when there is activity happening in the rental queue of Hastings that is of interest to the customer, the customer can be notified of the activity. An example would be the sending out of a notification when a new DVD title is being shipped to the subscriber, or when a new movie is being added to the queue based on the item recommendation system determining a new movie that satisfies the predetermined subscriber preferences (column 8, lines 43-60). With respect to the language reciting that the notification is based on the quantity of items remaining in the queue, the examiner takes "official notice" that it is well known to notify customers of the fact that an account is getting low and that the account balance needs to be modified. An example would be a financial account where customers can be notified of a low account balance so that the customer can take steps to ensure that the balance is kept at a satisfactory level. Children going to elementary school use meal cards (pre-paid cards) to pay for meals. When the account balance is getting low the school sends out a notification to the parents to inform them that the meal card balance is getting low. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the customer with a notification when it is determined that their queue is empty and that a modification to the queue should occur if they want to receive more DVD items. The fact there are no movies in a subscriber's queue is something that the subscriber would like to know about (one of ordinary skill in the art would recognize this) so that they can modify the queue and receive another movie.

For claims 9,25,27,29, Hastings discloses a method for renting items from a content provider where the customer sets up a rental queue. A set of queue replenishment rules are employed to determine if the ordering of the titles in the queue should be changed or if an additionally playable media title should be added to the queue. When a DVD is returned (a trigger event) the system checks the queue rules (Max Out option and/or Max Turns) to determine if the ordering of the queue should be changed. When a new DVD is shipped, the ordering of the queue is changed because that title is taken out of the queue and is then in a checked out status. With respect to the addition of an additionally playable media item to the subscriber rental queue, Hastings discloses that the subscriber can choose preferences/attributes about what movies they would like to see and the content provider will automatically select those movies for the subscriber (a item recommendation system). See column 8, lines 43-60. This is considered to be the claimed item recommendation system because this aspect of the system of Hastings recommends movies based on the preferences that the subscriber has provided (i.e. horror movies released in 1999 or any adventure movies with Harrison Ford as an actor). The movies determined by the recommendation system are added to the queue as claimed. Not disclosed is a set of notification rules that, based on the monitoring of the queue, will electronically notify the subscriber when the ordering of the queue has been changed or when an additionally playable media item is being added to the queue. Elston discloses an automatic customer notification system that notifies customers of a business or other entity of the fact that an event has occurred that involves that business or entity. Elston discloses that when an event of

Art Unit: 3629

interest to the customer occurs, the system will notify the customer by phone, fax, or even email. See column 4, lines 1-5. Elston discloses in column 5, lines 3-12 that the system and method of customer notification can be used for accounts at financial institutions, for medical patients and test results, for college students and notification of the posting of grades. The invention is not limited to just the notification of financial events but can be used in other environments where notification of an event would be desirable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hastings with a notification system as disclosed by Elston so that when there is activity happening in the rental queue of Hastings that is of interest to the customer (renumbering of the ordering or the addition of a new movie from the recommender system), the customer can be notified of the activity. Examples would be the sending out of a notification when a new DVD title is being shipped to the subscriber (queue re-ordering) or when a new movie is being added (i.e. a new adventure movie with Harrison Ford was just released).

For claims 9,28, in addition to that immediately above, the prior art does not disclose that the newly added recommended playable media is designated as the next one to be delivered to the customer. Hastings discloses that one of the preferences that the subscriber can set is the order in which movies are to be received, see column 8, lines 43-65. This includes the situation where the subscriber decides that any movies recommended to them by the system of Hastings should be the next to be sent out. Because Hastings allows subscribers to have movies recommended by a recommender system and because Hastings allows a subscriber to set forth the priority for the

Art Unit: 3629

ordering of the movies to be sent, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hastings with the ability to designate any recommended movies as the next to be delivered to the subscriber.

With respect to claim 25, in addition to that stated above, the language defining the content of the notification is considered to be non-functional descriptive material. The notification is claimed as including "both an identification of an additional playable media title (satisfied by the prior art rejection set forth above), and "selectable feedback options" allowing removal of the playable item without further action by the subscriber. The feedback options are non-functional descriptive material. They are not used in any further manipulative step in the method claim. Claiming data of this kind that has no functional relationship to any claimed step is claiming non-functional descriptive material. If the feedback options are not used in any manner, then this content of the notification is non-functional descriptive material. The language "which is being added at the end of a first time period" is noted but is reciting a step that has not happened yet and is a step that may or may not occur in the future. This is not reciting a step in a positive sense, so it defines nothing further to what has been claimed. The language of the last paragraph has been addressed in the 112 rejection for claim 25.

For claims 33, not disclosed is that the movies are by the Internet (broadband). Hastings discloses that the movies can be delivered to the customer in just about any manner and discloses in column 4, lines 22-34 that the delivery channel "may be implemented by any mechanism that provides for the transfer of items" from the provider to the subscriber "and the invention is not limited to any particular type of

Art Unit: 3629

delivery channel". The examiner takes "official notice" that it is old and well known in the art to deliver movies by the Internet. Movies have been distributed via the Internet for years; one of ordinary skill in the art would be very informed of this fact. Based on the teachings of Hastings and the knowledge of one of ordinary skill in the art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system and method of Hastings for the delivery of movies by Internet broadband because this is just another delivery channel well known to one of ordinary skill in the art.

For claim 26, in Hastings, if the subscriber wants to remove the movie that was added by the recommender system, they can do so. Hastings discloses the claimed ability to remove movies from the subscriber queue because one can use "options" on the website to remove the added movie.

6. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al. (6584450) in view of Elston (6055505) and further in view of Jacobi et al. (6317722).

Hastings discloses a method for renting items from a content provider where the customer sets up a rental queue. A set of queue replenishment rules are employed to determine if the ordering of the titles in the queue should be changed or if an additionally playable media title should be added to the queue. When a DVD is returned (a trigger event) the system checks the queue rules (Max Out option and/or Max Turns) to determine if the ordering of the queue should be changed. When a new

Art Unit: 3629

DVD is shipped, the ordering of the queue is changed because that title is taken out of the queue and is then in a checked out status. With respect to the addition of an additionally playable media item to the subscriber rental queue, Hastings discloses that the subscriber can choose preferences/attributes about what movies they would like to see and the content provider will automatically select those movies for the subscriber (a item recommendation system). See column 8, lines 43-60. This is considered to be an item recommendation system because this aspect of the system of Hastings recommends movies based on the preferences that the subscriber has provided (i.e. horror movies released in 1999 or any adventure movies with Harrison Ford as an actor). The movies determined by the recommendation system are added to the queue as claimed.

Not disclosed is a set of notification rules that, based on the monitoring of the queue, will electronically notify the subscriber when the ordering of the queue has been changed or when an additionally playable media item is being added to the queue. Also not disclosed is that the recommendation system provides recommendations based at least in part on a composition of a rental queue.

Elston discloses an automatic customer notification system that notifies customers of a business or other entity of the fact that an event has occurred that involves that business or entity. Elston discloses that when an event of interest to the customer occurs, the system will notify the customer by phone, fax, or even email. See column 4, lines 1-5. Elston discloses in column 5, lines 3-12 that the system and method of customer notification can be used for accounts at financial institutions, for

Art Unit: 3629

medical patients and test results, for college students and notification of the posting of grades. The invention is not limited to just the notification of financial events but can be used in other environments where notification of an event would be desirable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hastings with a notification system as disclosed by Elston so that when there is activity happening in the rental queue of Hastings that is of interest to the customer (renumbering of the ordering in the queue or the addition of a new movie from the recommender system), the customer can be notified of the activity. Examples would be the sending out of a notification when a new DVD title is being shipped to the subscriber (queue re-ordering) or when a new movie is being added (i.e. a new adventure movie with Harrison Ford was just released).

With respect to the recommendations being based in part on a composition of the rental queue, Jacobi discloses the use of an item recommendation system that recommends items to users based on the content of a users shopping cart. See the Abstract as an example. Jacobi looks at what items the customer has added to their shopping cart list and recommends items based on those items in the shopping cart list. This is a teaching that recommendations can be based on the items that the customer has chosen and placed on a list. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the recommendation system of Hastings to in part base the recommendations on the content of the rental queue, which is a list of items chosen by the user, as is disclosed by Jacobi. Clearly, the items that the user themselves chooses are indicative of the interest that the user has. In view of

Art Unit: 3629

Jacobi that teaches using the items in a shopping cart list to generate recommendations, one of ordinary skill in the art would have found it obvious to use the content of the rental queue to generate recommendations. The rental queue is indicative of the interests of the users, so it would have been obvious to base the recommendations on the content of the queue as claimed. The recommendations are clearly going to be predicted to be more desirable than other items, such as items of a nature that the user does not indicate a preference for, and for items that the user does not have in their rental queue. This is inherent in making a recommendation. The recommendation is predicted to be more desirable than other things, that is what a recommendation is by definition.

Allowable Subject Matter

7. Claims 2-7,10-18,21-24 are allowed.
8. Applicant's arguments with respect to the prior art filed 2/28/07 have been fully considered but they are not persuasive.

The 112,2nd rejection has been withdrawn.

With respect to claim 8, the arguments are overall considered to be moot based on the new grounds of rejection. With respect to the allegation by applicant that operators of commercial DVD systems were required to "maintain a sufficient supply of media items....", and that a person skilled in the art would be taught away from the

Art Unit: 3629

claimed method, where is the evidence that backs up this allegation? Evidence cannot be introduced into the record by attorney comment. This argument is not persuasive.

With respect to the argument for claim 9, it is not addressing the obviousness statement set forth by the examiner. As stated in the rejection "*For claims 9,28, in addition to that immediately above, the prior art does not disclose that the newly added recommended playable media is designated as the next one to be delivered to the customer. Hastings discloses that one of the preferences that the subscriber can set is the order in which movies are to be received, see column 8, lines 43-65. This includes the situation where the subscriber decides that any movies recommended to them by the system of Hastings should be the next to be sent out. Because Hastings allows subscribers to have movies recommended by a recommender system and because Hastings allows a subscriber to set forth the priority for the ordering of the movies to be sent, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hastings with the ability to designate any recommended movies as the next to be delivered to the subscriber.*" The totality of the arguments is not seen as sufficient to overcome the rejection because the traversal never really sets forth why the feature is not considered to be obvious.

For claim 25, the newly added language has been addressed in the rejection of record. Not further comments are deemed necessary. The new language does not render the claim as allowable.

For claims 30-34, the examiner has read the claim in a fair and reasonable manner. The position of the examiner is not changed. The claim does not require what applicant has argued due to the "or" language.

With respect to the allegation on page 16 that the objective evidence demonstrates that Elston is inapplicable from an obviousness perspective, because the state of the art illustrates a long felt need for a solution as is claimed, where is there any showing of any long felt need? None has been provided and cannot be provided by way of attorney comment. That must be done via 37 CFR 1.132. The examiner is not clear on what this paragraph has to do with any previous arguments for the claims. This argument is not persuasive.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL
PRIMARY EXAMINER